IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 10. This sheet, which includes Figs. 10 and 11, replaces the original sheet including Figs. 10 and 11.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-11 and 13-14 are pending in the application. Claims 1-3, 5, 9, 11 and 14 are amended; and Claim 12 is canceled by the present amendment. Support for the amended claims can be found in the original specification, claims and drawings.[1] No new matter is presented.

In the outstanding Official Action, the drawings and Claims 1-3, 5, 8-9 and 14 were objected to for minor informalities; Claims 1-14 were rejected under 35 U.S.C. § 101; Claims 1-11 and 13 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,052,709 to Paul et al. (hereinafter Paul); and Claims 12 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul in view of U.S. Patent Publication No. 2001/0038625 A1 to Satoh.

As an initial matter, the Official Action asserts that foreign priority in the present application is not accepted because the inventors listed in the present application do not match those listed in the foreign priority document (JP P2002-245598). Applicants, however, respectfully traverse this assertion since the same inventors are listed in both applications, the only difference between the documents being the order of the inventor's names. For example, Tadao Takami is listed as the first inventor in the present application, whereas Masanori Fujita is listed as the first inventor in the foreign priority document.

Accordingly, Applicants submit that the inventors in both the present application and the foreign priority document are the same, and respectfully request that priority to the foreign priority document (JP P2002-245598) be accepted and acknowledged.

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[1] E.g., at least at original Claim 12.

In the outstanding Official Action, the drawings were objected to because the text corresponding to reference numerals "64" and "65" in the drawings do not "match with the description in the specification." In response, the text boxes in Fig. 10 corresponding to the above noted reference numerals are amended to be consistent with the text in the corresponding portion of the specification.

Further, Claims 1-3, 5, 8-9 and 14 were objected to because of minor informalities.

Regarding Claim 1, the Official Action suggests that "a letter string" be amended to recite "'letter strings' for clearer understanding." However, the mobile terminal may acquire one, or a plurality of letter strings from the detection conditions distributions server. Thus, the language "a letter string" in Claim 1, as presently presented, clearly recites the claimed subject matter.

Regarding Claims 3, 5, 8 and 9, the Official Action recommends amending features in these claims to rely on antecedent basis in claims from which they do not depend. For example, the Official Action recommends amending Claim 5 to recite "the user" instead of "a user" relying on the recitation of "a user" in Claim 2. Claim 3, however, does not depend from Claim 2, and amending Claim 3 to recite "the user" would cause this claim to be unclear since Claim 1, from which Claim 3 depends, fails to recite "a user." Therefore, Claims 3, 5, 8 and 9 are amended only to correct other minor informalities.

Otherwise, the claims are amended, as recommended in the Official Action and otherwise, to address minor informalities. Accordingly, Applicants respectfully request that the objections to the drawings and Claims 1-3, 5, 8-9 and 14 be withdrawn.

The Official Action rejected Claims 1-14 under 35 U.S.C. § 101, as directed to non-statutory subject matter, asserting that the claimed invention may be an abstract idea, and that "the final result achieved by the invention does not produce any tangible result." Applicants respectfully traverse this rejection.

Claims 1-11 are directed to an "mobile communication terminal," and Claims 13 and 14 are each directed to an apparatus (e.g., "server"). Applicants note that each of these claimed classes are statutory.

Further, Applicants respectfully submit that each of the claims are directed to a practical application having a result that is concrete, useful and tangible. Specifically, independent Claims 1, 13 and 14 are directed to a mobile terminal and respective servers that are configured to allow the mobile terminal to compare received e-mail messages to stored detection data, process (e.g., delete) unwanted messages, and reimburse user's for the annoyance of having to use service time to receive the unwanted messages. The servers maintain the detection data corresponding to unwanted messages, and provide the resources for reimbursing the user for service time charged for receiving unwanted messages. The criteria stored in the server may be distributed to, or downloaded by, the mobile devices which use the criteria to filter the received e-mail messages accordingly. Thus, the practical application of the invention is that unwanted messages are deleted from a user's in-box and a user can be reimbursed for service charges related to receiving this message.

The claimed invention also produces a concrete, useful and tangible result of, for example, receiving mail, acquiring and storing detection conditions, performing detection processing, sending information that mail has been extracted, storing information related to distribution processing, etc. At least each of independent Claims 1, 13 and 14 recite features that result in an output or result that is concrete, useful and tangible.

Therefore, the claims are directed to a practical application (e.g., extracting unwanted mail messages and reimbursing a user for such messages), which produces a useful, tangible and concrete result (e.g., receiving mail, extracting mail, reporting extracted mail, storing and processing detection data, performing a billing reduction processing, etc).

Further, with regard to Claims 1, 13 and 14, MPEP § 2106 provides that:

> Office personnel have the burden to establish a *prima facie* case
> that the claimed invention as a whole is directed to solely an abstract idea
> or to manipulation of abstract ideas or does not produce a useful result.
> Only when the claim is devoid of any limitations to a practical application
> in a technological arts should it be rejected under 35 U.S.C. § 101 . . .
> Further, when such a rejection is made, <u>office personnel must expressly
> state how the language of the claims has been interpreted to support the
> rejection</u>. (emphasis added) See MPEP § 2106.

Thus, Applicants respectfully submit that no express statement has been provided as
to how the <u>language of the claims</u> have been interpreted to support the 35 U.S.C. § 101
rejection in violation of the guidelines of MPEP § 2106.

Should such rejection be maintained in a subsequent communication with respect to
any of the aforementioned claims, Applicants respectfully request the Examiner provide an
express statement on the record in accordance with MPEP § 2106 guidelines explaining how
such claim terminology, such as "acquiring detection conditions", "storing the detection
condition data", "performing detection processing", sending information that the mail has
been extracted", "controlling detection condition data", "storing information regarding
distribution processing", "receiving information regarding mail", "sending instruction
information", "perform reduction processing", etc. are interpreted.

More specifically, how such limitations are deficient to define a useful, concrete and
tangible result. See <u>State Street Bank & Trust Co. v. Signature Financial Group, Inc.</u>, 149
F.3d 1368, 1374, 47 (Fed. Cir. 1998) (discussing practical application of a mathematical
algorithm, formula, or calculation.).

Therefore, Applicants respectfully submit that Claims 1-11, 13 and 14 recite statutory
subject matter directed to a practical application that produces a useful, concrete and tangible
result. Accordingly, for at least the reasons discussed above, Applicants respectfully request
that the rejection of Claims 1-11, 13 and 14 under 35 U.S.C. § 101 be withdrawn.

By the present amendment, Claim 1 is amended to incorporate the subject matter of
Claim 12, which was rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Paul</u> in view of

Satoh. In response to this rejection, Applicants respectfully submit that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied references.

Amended independent Claim 1 relates to a mobile communications terminal that is configured to filter out and delete unwanted e-mail messages using detection data retrieved from an external server. Specifically, amended independent Claim 1 recites a mobile communication terminal that includes a mail receiving means for receiving mail from a mail server, and a detection conditions acquisition means for acquiring detection conditions data including a letter string from a detection conditions distribution server and storing the detection condition data in a detection conditions storage means. A detection means for performing detection processing is also included in the mobile terminal and extracts the mail received by the mail receiving means when a condition, in which the mail includes a letter string conforming to the letter string included in the detection condition data stored in the detection conditions storage means, is satisfied The mobile communications terminal also comprises:

> …detected mail notification processing means for
> **_sending information that the mail has been extracted by the_**
> **_detection means to a detected mail notification receiving_**
> **_server._**

As described at Figs. 13-14, and the corresponding description in the specification, the reporting of an extracted e-mail message to the detected mail notification receiving server (70) allows for a user to be reimbursed for charges associated with receiving unwanted mail (e.g., spam).

In addressing this claimed "detected mail notification processing means" feature, the Official Action cites col. 7, lines 1-8 of Paul, and states that the reference describes that "all detected mails are stored at a special folder in the user's in-box." The Official Action then admits that Paul "does not disclose for sending the detected mail information to the detected

mail notification receiving server from a mobile communication terminal for the communication charge purpose." In an attempt to remedy this deficiency, the Official Action relies on <u>Satoh</u> and asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to arrive at Applicant's claims. Applicants, however, respectfully traverse this rejection, as <u>Satoh</u> fails to teach or suggest the claimed features for which the reference is asserted under 35 U.S.C. § 103.

<u>Satoh</u> describes a pre-charge notification system in which the total number of packets to be transmitted in a communication is determined and a charge related to the transmission of the communication is calculated.[2] A user may then authorize or prevent transmission of the communication based on the calculated communication charge.

<u>Satoh</u>, however, fails to teach or suggest a "detected mail notification processing means for ***sending information that the mail has been extracted by the detection means to a detected mail notification receiving server***," as recited in amended independent Claim 1.

In addressing this claimed feature, the Official Action relies on ¶[0025] and Fig. 1B of <u>Satoh</u>. This cited portion of <u>Satoh</u> describes that information about the calculated communication charge includes various pieces of information about the communication and the services used to complete the communication. The Official Action further states that "the general concept of calculating, storing, and displaying communication charge through a mobile station is well known."

However, amended Claim 1 is not directed to calculating, storing and displaying a communication charge. Instead, as noted above, Claim 1 is directed to a mobile device that ***sends information that the mail has been extracted by the detection means to a detected mail notification receiving server***. Thus, the mobile station has already received a mail that was extracted by the detection means, and reports this extraction to a server which can then

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[2] <u>Satoh</u>, Abstract.

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remove the charges associated with the received message from the user's bill. At no point does Satoh teach or suggest that a received mail is extracted by a detection means, or that the result of this detection is reported to a server, whatsoever.

Therefore, Paul and Satoh, neither alone, nor in combination, teach or suggest a mobile station comprising a "detected mail notification processing means for *sending information that the mail has been extracted by the detection means to a detected mail notification receiving server*," as recited in amended independent Claim 1.

Accordingly, Applicants submit that amended independent Claim 1 patentably defines over Paul and/or Satoh and respectfully requests that outstanding rejection thereto under 35 U.S.C. § 102 be withdrawn.

Claims 14 was also rejected under 35 U.S.C. § 103(a) as unpatentable over Paul in view of Satoh. Applicants respectfully traverse this rejection as Claim 14 recites novel features clearly not taught or rendered obvious by the applied references.

Independent Claim 14 relates to a detected mail notification receiving server, comprising:

> detected mail receiving means for receiving *information regarding mail including a first letter string conforming to a second letter string for detecting specific mail which is sent by a mobile communication terminal*; and communication charge return instruction means for sending instruction information for *instructing billing control server to perform reduction processing of the communication charge for the mail to the billing control server*, based on information regarding the mail received by the detected mail receiving means.

As discussed above, and as described in reference to Figs. 12-14, the detected mail notification receiver server is sent "information" when a mail is extracted at the mobile terminal, and instructs the billing control server to reduce the charge for a user to reimburse for the service time used to receive the unwanted message.

As noted above with respect to amended Claim 1, <u>Paul</u> and/or <u>Satoh</u> neither alone, nor in combination, teach or suggest sending information that the mail has been extracted by the detection means to a detected mail notification receiving server. Therefore, for substantially similar reasons, the references fail to teach or suggest "***receiving information regarding mail including a first letter string conforming to a second letter string for detecting specific mail which is sent by a mobile communication terminal,***" as recited in independent Claim 14.

Further, the Official Action fails to address the "communication charge return" feature recited in Claim 14, whatsoever. In this regard, neither <u>Paul</u> nor <u>Satoh</u> teach or suggest "***instructing billing control server to perform reduction processing of the communication charge for the mail to the billing control server,***" much less that such reduction processing is performed based on information regarding the mail received by the detected mail receiving means.

Therefore, <u>Paul</u> and <u>Satoh</u>, neither alone, nor in combination, teach or suggest the above noted features recited in independent Claim 14. Accordingly, Applicants respectfully request that the rejection of Claim 14 under 35 U.S.C. § 103 be withdrawn.

Claim 13 was rejected under 35 U.S.C. § 102(b) as anticipated by <u>Paul</u>. In response to this rejection, Applicants respectfully submit that independent Claim 13 recites novel features clearly not taught or rendered obvious by the applied reference.

Independent Claim 13 recites a detection conditions distribution server for controlling detection condition data including a letter string for extracting specific mail received by a mobile communication terminal. The detection conditions distribution server comprises, in part,

> second detected mail processing control means for
> storing information regarding distribution processing for
> specifying that each of a plurality of mobile communication
> terminals automatically deletes mail or that a user is allowed to
> select the deletion, when the mail received by each of the
> plurality of mobile communication terminals which acquires

the detection condition data satisfy the condition in which the mail include letter strings conforming to the letter string included in the detection condition data, ***based on specification by an administrator of each of the plurality of mobile communication terminals such that each piece of the information is associated with the information for identifying each of the mobile communication terminals***.

The Official Action fails to specifically address any of the features of Claim 13, whatsoever. Nonetheless, p. 5 of the Official Action appears to indicate that Claim 13 is anticipated by Paul.

Paul describes creating one or more spam probe e-mail addresses, which are planted at various sites to ensure their inclusion on large-scale spam mailing lists. Based on the unsolicited spam e-mail received, the system generates an alert signal which is broadcast to various system components and used to filter e-mail traffic.[3]

Paul, however, fails to teach or suggest that the messages are filtered based on ***specification by an administrator of each of the plurality of mobile communication terminals such that each piece of the information is associated with the information for identifying each of the mobile communication terminals***, as recited in independent Claim 13. In contrast, as discussed above, Paul describes that the same alerts are broadcast to a plurality of system components, and the alerts are used to perform a system-wide filtering of all e-mail from a similar source. The server of Claim 13 allows for the administration of detection data by an administrator on a terminal-by-terminal basis ***such that each piece of the information is associated with the information for identifying each of the mobile communication terminals***. Paul fails to teach or suggest this claimed feature.

Accordingly, Applicants respectfully request that the rejection of Claim 13 under under 35 U.S.C. § 102 be withdrawn.
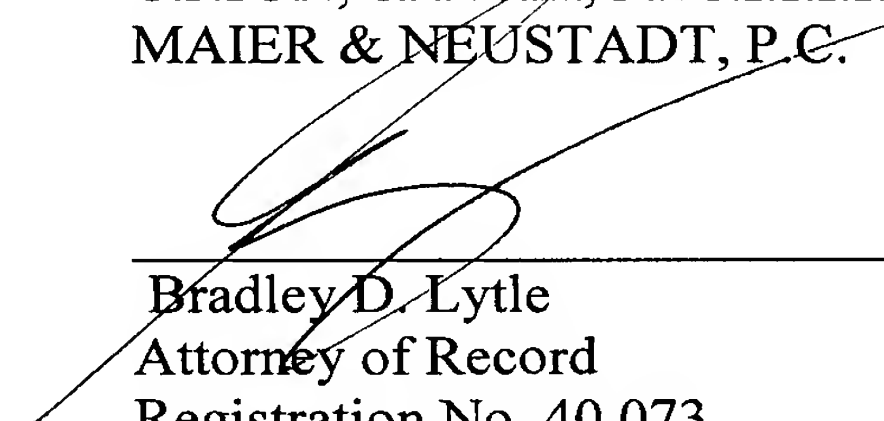
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[3] Paul, Abstract.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-11, 13 and 14 is definite and patentably distinguishing over the applied references. The present application is therefore believed to be in condition for formal allowance and an early and favorable consideration of the application is therefore requested.

Respectfully submitted,

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